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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,547	06/29/2001	Jonathan Sharp	367.40282X00	4444

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EXAMINER

LESNIEWSKI, VICTOR D

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/893,547

**Applicant(s)**

SHARP ET AL.

**Examiner**

Victor Lesniewski

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. The amendment filed 5/16/2005 has been placed of record in the file.
2. Claims 1-14 have been canceled.
3. Claims 15-22 have been added.
4. Claims 15-22 are now pending.
5. The applicant's arguments with respect to claims 15-22 have been considered but are moot in view of the following new grounds of rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 15-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Peng (U.S. Patent Number 6,816,944).
8. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a system or a server are rejected under the same rationale applied to the described claim.
9. Peng has disclosed:

- <Claims 15, 18, and 22>

A method for downloading adaptation data from a server to a portable radio communication device, said method comprising: providing electronic content for storage on a memory of said portable radio communication device (column 5, lines 1-16; column 7, lines 12-18; and column 8, lines 8-18 and 31-48); providing said adaptation data on a memory of said server (column 15, lines 3-26); allowing access to said adaptation data on said server for downloading from said memory of said server to said portable radio communication device (column 15, lines 3-26); downloading said adaptation data from said memory of said server to said portable radio communication device (column 15, lines 3-26); monitoring downloading of said adaptation data by said portable radio communication device from said memory of said server to provide output data (column 7, lines 38-44); applying said adaptation data to said electronic content so as to modify said electronic content to provide adapted electronic content (column 15, lines 20-26); generating data based on the output data of said monitoring downloading of said adaptation data (column 7, lines 38-44); and computing remuneration data related to the electronic content and the adaptation data based on the generated data (column 7, lines 44-46).

- <Claims 16 and 19>

A method according to claim 15, wherein: a content provider provides said electronic content for storage on the memory of said portable radio communication device (column 8, lines 8-18 and 31-48); the content provider provides said adaptation data for storing on the memory of said server (column 15, lines 3-15); a content enabler allows access to said

adaptation data for downloading from said memory of said server to said portable radio communication device (column 15, lines 13-26); and the content enabler provides for monitoring downloading of said adaptation data by said portable radio communication device from the server, generating data based on monitoring downloading of said content, and computing the remuneration data based on the generated data, the content enabler determining payment data for said content provider based on said remuneration data (column 7, lines 38-46).

- <Claims 17 and 20>

A method according to claim 15, wherein the electronic content comprises original games content and the adaptation data comprises supplementary software for modifying the original games content (column 1, lines 35-43 and column 15, lines 15-20).

- <Claim 21>

A portable radio communication device operable in a radio communication network including a server, the portable radio communication device being capable of downloading adaptation data from the server, the portable radio communication device having a transceiver, a memory and a controller (column 5, lines 1-16 and column 7, lines 12-18), wherein: the memory stores electronic content (column 8, lines 8-18 and 31-48); the controller is operable to control the transceiver to transmit a request for adaptation data from the server, the request comprising an identifier of the electronic content stored on the device and security data, the identifier and the security data enabling the server to download the adaptation data to the portable radio communication device, the transceiver receives said adaptation data from the server, and the controller modifies the electronic

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content stored on the memory by applying to the electronic content the received adaptation data to provide adapted data which is stored on said memory (column 7, lines 48-53 and column 15, lines 3-26); the transceiver in response to said storing of the adaptation data transmits an acceptance signal (column 7, lines 38-44); and said acceptance signal is used by the server for computing remuneration data related to the adaptation data (column 7, lines 44-46).

Since all the limitations of the invention as set forth in claims 15-22 were disclosed by Peng, claims 15-22 are rejected.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure.

- Jackson (U.S. Patent Number 6,516,466) disclosed a portable digital entertainment system for "on demand" distribution of digital data, such as songs or video games.
- Naim (U.S. Patent Number 6,779,115) disclosed a method for securely downloading digital music data that includes a portable handheld device having a detachable smart card.
- Leermakers (U.S. Patent Number 6,928,468) disclosed a system that includes a plurality of portable clients, a server that stores software applications, and a broadcast system that broadcasts the software applications over a network.

11. The applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). The applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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